

REMARKS:

By this Amendment, claims 12-15 and 21 are cancelled, thereby leaving claims 16-20 and 22-31 unchanged.

Applicant wishes to thank Examiners Tompkins and Welch for the time required to prepare and conduct the telephonic interview on October 24, 2007. In the telephonic interview, the claim rejections and the cited art were discussed. Also, the cancellation of apparatus claims 12-15 was discussed. Further, Undersigned indicated that the cited art does not teach or suggest many of the method steps in claims 16-20 and 22-31. Examiner Welch agreed that at least Lathan does not teach or suggest the methods claimed in claims 16-20 and 22-31, and indicated that an additional search may be required.

Claim Rejections

Claims 16-20 and 22-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lathan alone.

Independent claim 16 recites:

A method for using disposable outerwear in a sports or athletic endurance event having a defined route comprising the steps of:
distributing the outerwear to a plurality of activity participants;
providing a plurality of containers along the event route for retaining the outerwear and/or parts thereof as it is discarded by the participants;
collecting the discarded outerwear and/or parts thereof; and
recycling the discarded outerwear and/or parts thereof.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of presenting a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). One of the three prongs required to establish a *prima facie* case of obviousness is that the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§ 706.02(j), 2143.03.

Lathan discloses an outer protective garment apparatus for protecting a user's cloths. Lathan does not disclose a single method of using the outer protective garment and, particularly, does not disclose the method recited in independent claim 16.

Accordingly, Lathan does not teach or suggest a method for using disposable outerwear in a sports or athletic endurance event as claimed in claim 16. More particularly, Lathan does not teach or suggest, inter alia, distributing disposable outerwear to a plurality of activity participants, providing a plurality of containers along the event route for retaining the outerwear and/or parts thereof as it is discarded by the participants, collecting the discarded outerwear and/or parts thereof, and recycling the discarded outerwear and/or parts thereof. The Examiner admits on page 3, last paragraph, of the final Office Action mailed August 31, 2007 that Lathan "does not state the method for using the disposable outerwear", but contends that it would be obvious to one of ordinary skill in the art to use the outer wear as claimed. The Examiner makes this statement without providing any teaching or suggestion within Lathan of the claimed method. Merely stating that a method is obvious without identifying any teaching or suggestion within Lathan is clearly improper. In addition, it is difficult to understand how a method would be obvious when not a single step of the method is disclosed in Lathan. Accordingly, a *prima facie* case of obviousness has not been established for independent claim 16 since Lathan does not teach or suggest all the subject matter of independent claim 16.

For these and other reasons, independent claim 16 is allowable. Claims 17-20 depend from independent claim 16 and are allowable for the same and other reasons as independent claim 16.

Independent claim 22 recites:

A method for using disposable outerwear in a sports or athletic activity, the method comprising:

- providing the outerwear to an activity participant, the outer wear including a plurality of perforations disposed thereon for facilitating quick removal and the outerwear being made of a material that is lightweight, strong, vapor-permeable, water resistant, puncture resistant and abrasion resistant;
- positioning the outerwear on a the activity participant;
- participating in the activity with the outerwear on the activity participant;
- removing at least a portion of the outerwear from the activity participant during the activity by tearing the outerwear along the perforations; and
- disposing of the at least a portion of the outerwear removed from the activity participant.

As indicated above, Lathan discloses an outer protective garment apparatus for protecting a user's cloths. Lathan does not disclose a single method of using the outer protective garment and, particularly, does not disclose the method recited in independent claim 22.

Accordingly, Lathan does not teach or suggest a method for using disposable outerwear in a sports or athletic activity as claimed in claim 22. More particularly, Lathan does not teach or suggest, inter alia, providing disposable outerwear to an activity participant, the outerwear including a plurality of perforations disposed thereon for facilitating quick removal and the outerwear being made of a material that is lightweight, strong, vapor-permeable, water resistant, puncture resistant and abrasion resistant, positioning the outerwear on a the activity participant, participating in the activity with the outerwear on the activity participant, removing at least a portion of the outerwear from the activity participant during the activity by tearing the outerwear along the perforations, and disposing of the at least a portion of the outerwear removed from the activity participant. The Examiner admits on page 3, last paragraph, of the final Office Action mailed August 31, 2007 that Lathan "does not state the method for using the disposable outerwear", but contends that it would be obvious to one of ordinary skill in the art to use the outer wear as claimed. The Examiner makes this statement without identifying any teaching or suggestion within Lathan of the claimed method. Merely stating that a method is obvious without identifying any teaching or suggestion within Lathan is clearly improper. In addition, it is difficult to understand how a method would be obvious when not a single step of the method is disclosed in Lathan. Accordingly, a *prima facie* case of obviousness has not been established for independent claim 22 since Lathan does not teach or suggest all the subject matter of independent claim 22.

For these and other reasons, independent claim 22 is allowable. Claims 23-31 depend from independent claim 22 and are allowable for the same and other reasons as independent claim 22.

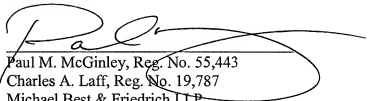
CONCLUSION:

In view of the foregoing, entry of the present Amendment and allowance of claims 16-20 and 22-31 are respectfully requested.

The undersigned is available for telephone consultation during normal business hours.

Date: October 24, 2007

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'Paul', is written over a horizontal line.

Paul M. McGinley, Reg. No. 55,443
Charles A. Laff, Reg. No. 19,787
Michael Best & Friedrich LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
Chicago, IL 60601
(312) 222-0800

Docket No. 205236-9007